

The Objection to the Specification Under 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o)

The Office Action objects to the specification under 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o) as failing to provide proper antecedent basis for the subject matter recited in Claim 52.

In particular, the Office Action asserts:

[I]f the language ‘successive tiers of bonus levels’ (clm 52, lines 4-8, 30-33) refers to bonus point levels as in successive bonus points accumulated up to a singular prize level, the language does not have proper antecedent with respect to originally filed specification. Essentially, the claim language ‘bonus level’ is used in the art to mean prize level; however, the language has been interpreted herein to be successive bonus [point] levels which are not successive prize levels but rather successive points to reach the only prize commensurate with that found in claim 54, lines 10-17.

In response, Applicants submit that the amendment to Claim 52 obviates any basis for the objection thereto. Reconsideration and withdrawal of the objection are respectfully requested.

The Objection Under 35 U.S.C. § 132

The Office Action objects to the amendment filed November 20, 2000, asserting that the amendment introduces new matter. In particular, the Office Action asserts the following enumerated points to which Applicants respond below:

1. The Office Action asserts that the term “player participation indicator” recited in Claims 72 and 73 is not taught in the original specification. In response, Applicants submit that the amendment to Claims 72 and 73 obviates any basis for the objection thereto. Reconsideration and withdrawal of this aspect of the objection are respectfully requested.

2. The Office Action asserts that term “successive tiers of bonus levels” recited in Claim 52 is not taught in the original specification. In response, Applicants submit that the amendment to Claim 52 obviates any basis for the objection thereto. Reconsideration and withdrawal of this aspect of the objection are respectfully requested.

The Rejection Under 35 U.S.C. § 112, First Paragraph

The Office Action rejects Claims 52, 53, 72 and 73 under 35 U.S.C. § 112, first paragraph, asserting that Claims 52, 53, 72 and 73 are not supported by the specification as filed for the reasons discussed above with regard to the objection under 35 U.S.C. § 132. In response, Applicants submit that the amendment to Claims 52 and 53 and the cancellation of Claims 72 and 73 obviates any basis for the rejection under 35 U.S.C. § 112, first paragraph. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are respectfully requested.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The Office Action rejects Claims 56-58 and 94 under 35 U.S.C. § 112, second paragraph, asserting the following enumerated points to which Applicants respond below:

1. That the device recited in Claims 56-58 is “inept in that the steps are manual playing steps performed by humans rather than the structure of the device.” In response, Applicants submit that the amendment to Claims 56-58 obviates any basis for the rejection of these claims under 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of this aspect of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.
2. That the phrase “rules of play” recited in Claim 94 is “indefinite for attempting to claim steps of an auxiliary game within an apparatus claim where the steps are undefined therein due to failure to definitively claim the particular steps to play the auxiliary game...” In response, Applicants submit the amendment to Claim 94 obviates any basis for the rejection of this claim under 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of this aspect of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

The Rejections Under 35 U.S.C. § 103

The Rejection Over Forte et al. In View of Ten Stix 21

The Office Action rejects Claims 68-71, 74-78 and 94 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,586,766 to Forte et al. in view of the prior Ten Stix 21 game disclosed in the specification (“prior game”). Applicants respectfully traverse the rejection.

Claim 68, the only independent claim involved in this rejection, is addressed as follows. Applicants submit that Forte et al., alone or combined with the prior game does not disclose or suggest the invention recited in Claim 68.

Claim 68 is directed to an apparatus for controlling and displaying each player’s progress in an auxiliary incentive game played simultaneously with a principal or primary casino table game. The apparatus of Claim 68, which includes a controller connected to a bonus point display that indicates a bonus point award for each player, maintains a number of bonus points received by each of the players when the input device indicates that no new bonus point is to be awarded.

Forte et al. discloses a card game system that contains a plurality of player counters. See Abstract. The plurality of player counters count tally events related to the game being played. Id. Forte et al. discloses that the jackpot tally events occurring are such events as consecutive natural or blackjack hands by the players or other winning hands consecutively occurring (see, e.g., column 3, lines 47-49; column 4, lines 4-19) or other lower probability player events such as a twenty-one hand count, or relatively low probability dealer events such as consecutive dealer busts or naturals. Forte et al. discloses that the game includes zeroing the player count values of all players not identified as having been dealt jackpot count hands in the current hand. See column 4, lines 45-48; column 7, line 66 to column 8, line 8; column 8, lines 22-29; and Claims 1 and 3-6. In contrast, Claim 68 provides an incentive for players to play regardless of whether the players are winning or losing the card game by providing a random event that regularly occurs without the

need for consecutive combinations of events. Forte et al. does not disclose or suggest a game system that includes a controller that maintains a number of bonus points received by each of the players when the input device indicates that no new bonus point is to be awarded.

The prior game involved the use of lammers in order to tally bonus points received by a player in an auxiliary game. The prior game did not involve the use of a controller that maintains a number of bonus points received by each of the players when an input device indicates that no new bonus point is to be awarded, as claimed. The present specification discloses that the use of lammers in the prior Ten Stix 21 game had disadvantages. For instance, the specification discloses that the use of lammers provided opportunities for a dishonest player to defeat a stated purpose of the auxiliary game because such players could illegally transfer or remove the lammers from the gaming table, thereby removing the incentive for such players to stay at the game table. The claimed invention, in contrast, is directed to an apparatus that controls and displays each player's progress in the auxiliary game without the use of lammers. The claimed invention thus removes any opportunity for players to illegally use the bonus incentives provided by the auxiliary game.

Thus, the invention recited in Claim 68 is non-obvious under 35 U.S.C. §103. Reconsideration and withdrawal of the rejection of Claim 68 under 35 U.S.C. § 103 are respectfully requested, and Applicants submit that Claim 68 is now in condition for allowance. As Claims 69-71, 74-78, 94 and newly added Claim 95 depend from allowable Claim 68, Applicants further submit that these claims are likewise in condition for allowance.

**The Rejection Over Forte et al. In View of Ten Stix 21
and Further In View of Either Paulsen or Huard or Jones**

The Office Action rejects Claims 72 and 73 under 35 U.S.C. § 103 as being obvious over Forte et al. in view of the Ten Stix 21 game disclosed in the specification (“prior game”) and further in view of either U.S. Patent No. 5,393,067 to Paulsen or U.S. Patent No. 5,743,800 to Huard or U.S. Patent No. 5,544,893 to Jones. Applicants respectfully traverse the rejection.

Claims 72 and 73 are canceled. Thus, the rejection is obviated. Reconsideration and withdrawal of the rejection of Claims 72 and 73 under 35 U.S.C. § 103 are respectfully requested.

**The Rejection of Claims 54-65 and 67 Over Forte et al.
In View of Ten Stix 21 and Further In View of Adams**

The Office Action rejects Claims 54-65 and 67 under 35 U.S.C. § 103 as being obvious over Forte et al. in view of the Ten Stix 21 game disclosed in the specification (“prior game”) and further in view of U.S. Patent No. 5,848,932 to Adams. Applicants respectfully traverse the rejection.

Claim 54, the only independent claim involved in this rejection, is addressed as follows. Forte et al., alone or combined with the prior game and/or Adams does not disclose or suggest the invention recited in Claim 54.

Claim 54 is directed to a device for play of an auxiliary incentive game by a plurality of players simultaneously with a card game played with a plurality of cards. The device includes a plurality of manipulable interface units. Each of the plurality of manipulable interface units includes a display unit that displays the number of bonus points accumulated by the associated player. In addition, each of the plurality of manipulable interface units can be manipulated by the associated player to select a prize. Neither Forte et al., the prior game or Adams discloses or suggests a device for play of an auxiliary incentive game that includes plurality of manipulable

interface units can be manipulated by the associated player to select a prize. Thus, the combination of references applied by the Office Action do not render obvious the invention recited in Claim 54. Reconsideration and withdrawal of the rejection of Claim 54 under 35 U.S.C. § 103 are respectfully requested, and Applicants submit that Claim 54 is now in condition for allowance. As Claims 55-65 and 67 depend from allowable Claim 54 Applicants submit that Claims 55-65 and 67 are likewise in condition for allowance.

**The Rejection of Claims 48-53, 66 and 75-93 Over
Forte et al. In View of Ten Stix 21 and Further In
View of Adams and Further In View of Pickardt**

The Office Action rejects Claims 48-53, 66 and 75-93 under 35 U.S.C. § 103 as being obvious over Forte et al. in view of the Ten Stix 21 game (“prior game”) disclosed in the specification, further in view of Adams, and further in view of Great Britain Patent Publication No. 2201821A to Pickardt.

Claims 48, 50 and 52, the only independent claims involved in this rejection, are addressed as follows. (Claim 66 depends from Claim 60, which in turn depends from Claim 54. As discussed above, Claim 54 is not disclosed or suggested in the cited references. Thus, it is submitted, dependent Claim 66 is also not disclosed or suggested.)

Claims 48 and 50 are directed to a device for controlling and displaying each player’s progress in an auxiliary incentive game played simultaneously with a principal or primary casino table game that includes a bonus point display, a controller, a prize display and a dealer interface unit. The bonus point display includes a player interface unit associated with each player of the primary game. The player interface unit includes a player control element manipulated by the associated player to select a prize.

Claim 52 is directed to a method for a plurality of players to play an auxiliary game in conjunction with a card game that includes providing a bonus point display, providing a controller, providing a prize display and providing a dealer interface unit. The bonus point display includes a player interface unit associated with each player of the primary game. The player interface unit includes a player control element manipulated by the associated player to select a prize.

Neither Forte et al., the prior game, Adams or Pickardt discloses or suggests a method that involves the use of a device for play of an auxiliary incentive game that includes a manipulable interface unit that can be manipulated by the associated player to select a prize, as claimed. Thus, the combination of references applied by the Office Action do not render obvious the invention recited in Claims 48, 50 and 52. Reconsideration and withdrawal of the rejection of Claims 48, 50, and 52 under 35 U.S.C. § 103 are respectfully requested, and Applicants submit that Claims 48, 50, and 52 are in condition for allowance. As Claim 49 depends from Claim 48, Claim 51 depends from Claim 50, and Claims 53, 66, and 75-93 depend from allowable Claim 68, as discussed above, Applicants submit that these claims are likewise in condition for allowance.

Further, with regard to each of the rejections under § 103 in the Office Action, it is respectfully submitted that the Examiner has not yet set forth a prima facie case of obviousness. The PTO has the burden under § 103 to establish a prima facie case of obviousness. In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under § 103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could be modified to meet the claim is insufficient to establish obviousness. The PTO "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." Id. In order to establish obviousness, there must be a suggestion or

motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

With regard to the Examiner's argument that the combining of features from Forte et al. with the additional cited art, as well as the Examiner's alternative argument that the Ten Stix 21 auxiliary game and the automated counting features of Forte et al. are obvious for the blanket purpose of easing record keeping responsibilities of the dealer, it is respectfully submitted that this argument fails at least because such combinations do not address the problems of providing a card game with the disclosed auxiliary game and preventing improper play by players that occurs with use of such methods as distribution of lammers and other features and play as specifically claimed in claims 48-55, 59-71 and 74-94. The Examiner indicates no specific teaching or suggestion within the prior art that would support the combination made.

For all of the above reasons, it is respectfully submitted that the claims now pending patentably distinguish the present invention from the prior art of record. Accordingly, reconsideration and withdrawal of the outstanding prior art rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the attorney of record for this matter at the number listed below.

Respectfully submitted,

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